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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,224	08/27/2003	Masaki Sano	03151	4309
23338	7590	06/30/2005		EXAMINER
DENNISON, SCHULTZ, DOUGHERTY & MACDONALD 1727 KING STREET SUITE 105 ALEXANDRIA, VA 22314			MONDT, JOHANNES P	
			ART UNIT	PAPER NUMBER
			2826	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/648,224	SANO, MASAKI	
	Examiner Johannes P. Mondt	Art Unit 2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 24 May 2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 3 and 7-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 3 and 7-10 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/31/5, 5/12/5.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/05 has been entered.

***Response to Amendment***

Amendment filed 5/2/05 After Final Rejection mailed 2/7/05 has been entered following said Request for Continued Examination. In said Amendment Applicant cancelled 1, 2 and 4 and newly added claims 7-10. Claims 3 and 7-10 are in the application. Comments on Remarks in said Amendment are included below under "Response to Arguments".

***Information Disclosure Statement***

The examiner has considered the items listed on the Information Disclosure Statements filed January 31, 2005 and May 12, 2005. Signed copies of the corresponding Forms PTO-1449 are herewith enclosed.

***Response to Arguments***

2. Applicant's arguments filed 5/2/05 have been fully considered but they are not persuasive. In view of the substantial amendment of the entire claim language a new search was necessitated as the art rejection based on Reeh et al has been successfully

overcome: Reeh et al does not teach both a transparent resin and an outer surface of said transparent sealing resin with a dye, as two separately identifiable elements need to be in the prior art. However, this is found to be the case in Komoto et al (6,340,824 B1). In this regard it is noted that a phosphor particle qualifies as dye because said phosphor particle introduces a color otherwise absent.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The term "blueish" in claim 9 is a relative term which renders the claim indefinite. The term "blueish" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

5. The term "yellowish" in claim 9 is a relative term which renders the claim indefinite. The term "yellowish" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

6. The term "reddish" in claim 9 is a relative term which renders the claim indefinite. The term "reddish" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

7. The term "greenish" in claim 9 is a relative term which renders the claim indefinite. The term "greenish" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. ***Claims 3 and 7-10*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Komoto et al (6,340,824 B1) in view of prior art as admitted by Applicant (APAA).

*First addressing the independent claim 7:* Komoto et al teach a chromaticity-corrected LED device (see "Summary of the Invention" and Figure 32B) comprising: an LED mounted on a substrate 52 (col. 16, l. 35); transparent resin 540 (Figure 32B and col. 26, l. 22-31) sealing the LED, the transparent resin including "fluorescent material" distributed therein for changing a chromaticity of light emitted from the LED to a desired chromaticity based on an expected chromaticity of the light emitting from the LED (the limitation "for forming.." recited here conveys the purpose indeed also of the prior art, the purpose being to change the wavelength distribution and thus the chromaticity, but is without patentable weight, constituting functional language); and an outer surface 540A (col. 26, l. 23) (upper surface region of said resin having an increased

concentration of phosphor particles) of the transparent sealing resin comprising a dye (the examiner's position is that a phosphor is a dye because given incident light the phosphor changes said light into a different color, thus coloring (=dyeing) the substrate). The final limitation "based upon a measurement of chromaticity of the light emitted from the LED" is without patentable weight in the present device application (as opposed to a method application) because the final structure is not further limited by said limitation. Komoto et al do not necessarily teach said fluorescent material to be phosphor particles. However, Komoto et al recites said fluorescent material as "fluorescent material or any other appropriate material having a wavelength converting function (see Abstract), while Applicant admits as prior art on page 1 of the Specification the selection of phosphor particles for said wavelength converting function (lines 19-21). Applicant is reminded that Applicant is reminded in this regard that it has been held that mere selection of known materials generally understood to be suitable to make a device, the selection of the particular material being on the basis of suitability for the intended use, would be entirely obvious. *In re Leshin* 125 USPQ 416.

*On claim 3:* the dye (of phosphor particles) necessarily has a complementary color to the chromaticity of the light emitted from the LED because said dye in said LED changes the color of the emitted light so as to produce light that, in conjunction with the original light of the light-emitting element in the LED produces white light (see "Summary of the Invention", col. 3, l. 23-28)..

*On claim 8:* the LED device is for producing white light (see "Summary of the Invention", col. 3, l. 23-28).

*On claim 9:* as the emitted light is white light the LED emits the basic components of said white light, which are blueish light, yellowish light, reddish light or greenish light: white light has red, blue and green as basic components from which it can be built, which are included in the components of the light output due to the dye (see "Summary of the Invention"). To this extent, and with reference to the indefinite mature of the claim as noted above, said white light is all of the above.

*On claim 10:* because the dye (phosphor) changes the light of the LED into white light the color of the light emitted by said dye (phosphor) necessarily complements the light emitted by the LED.

### ***Conclusion***

**10.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Tasaki et al (6,319,425 B1) (see IDS filed January 31, 2005).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johannes P. Mondt whose telephone number is 571-272-1919. The examiner can normally be reached on 8:00 - 18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JPM  
June 24, 2005

Patent Examiner:



Johannes Mondt (Art Unit: 2826).